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08/052,414

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/052,414 04/22/93 ERSEK

R 910521, COR

EXAMINER

BRITTINGHAM, D

3341/1101

ART UNIT PAPER NUMBER

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3308

DATE MAILED:

11/01/93

11/01/93

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10-19-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 51-79 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☒ Claims 1-50 have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☐ Claims \_\_\_\_\_ are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

**EXAMINER'S ACTION**

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**Part III DETAILED ACTION**

*Claim Rejections - 35 USC § 112*

1. Claims 51, 52, 77 and 78 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 51, line 12, there is no antecedent basis for "the prosthetic particles."

With respect to claim 52, line 18, there is no antecedent basis for "the final implant."

With respect to claim 77, line 2, there is no antecedent basis for "the long-term."

With respect to claim 78, line 9, "indentations or porosities" constitutes an improper alternative expression; and, line 17, there is no antecedent basis for "the pores."

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 51-79 are rejected under 35 U.S.C. § 103 as being unpatentable over Tormala, et al. in view of Nashef, et al.

With respect to claims 51, 52, 77, 78 and 79, Tormala, et al. discloses the use of porous ceramic microparticles for filling in bodily defects. (See column 5, lines 24-50 and column 8, lines 19-21.) Nashef, et al. teaches the use of a physiological carrier to make the particles easier to mold, work with and apply. (See column 2, lines 11-13 and 38-40.) It would have been obvious to one of ordinary skill in the art to have included a physiological carrier with the particles of Tormala, et al., as taught by Nashef, et al., for ease of workability and molding in inserting the particles within the casing.

With respect to claims 53-55 and 57-60, see Tormala, et al. column 4, lines 21-24.

With respect to claim 56, see Nashef, et al. column 2, lines 36-41.

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With respect to claim 62, see Tormala, et al. column 5, lines 44-51.

With respect to claims 61, 63-72 and 75, see Nashef, et al. column 2, lines 9-13.

With respect to claims 73 and 74, see Tormala, et al. column 5, lines 24-27. With respect to claim 76, see Nashef, et al. column 2, lines 8-14.

#### *Conclusion*

4. With respect to Applicant's Information Disclosure Statements, please see MPEP 2004, paragraph 13. Also, see Rohn & Haas Co. v. Crystal Chemical, 722 F.2d 1556,1573, 220 USPQ 289 (Fed. Cir. 1983).

References AA-AK on page 1 and AA-AH on page 2 have not been considered because copies were not provided to the Examiner. References AL on page 1 and AL on page 2 have not considered because a translation was not provided to the Examiner.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S. Brittingham whose telephone number is (703) 308-0858.



dsb  
October 22, 1993



DAVID J. ISABELLA  
PRIMARY EXAMINER  
GROUP 3300